



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2011-0073]

RIN 0651-AC67

Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (Office) is proposing changes to the rules of patent practice to implement the preissuance submissions by third parties provision of the Leahy-Smith America Invents Act. This provision provides a mechanism for third parties to contribute to the quality of issued patents by submitting to the Office, for consideration and inclusion in the record of patent applications, any

patents, published patent applications, or other printed publications of potential relevance to the examination of the applications. A preissuance submission may be made in any non-provisional utility, design, and plant application, as well as in any continuing or reissue application. A third-party preissuance submission must include a concise description of the asserted relevance of each document submitted and be submitted within a certain statutorily specified time period. The third party must submit a fee as prescribed by the Director and a statement that the submission complies with all of the statutory requirements. The third-party preissuance submission provision of the Leahy-Smith America Invents Act is effective on September 16, 2012, and applies to any application filed before, on, or after September 16, 2012.

COMMENT DEADLINE: Written comments must be received on or before [Insert date 60 days after publication in the FEDERAL REGISTER].

ADDRESSES: Comments should be set be electronic mail message over the Internet addressed to: preissuance_submissions@uspto.gov. Comments may also be submitted by postal mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313 1450, marked to the attention of Nicole D. Haines, Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet because sharing comments with the public is more easily accomplished. Electronic comments are preferred to be submitted in plain text, but also may be submitted in ADOBE® portable document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format.

The comments will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Nicole D. Haines, Legal Advisor ((571) 272 7717), Pinchus M. Laufer, Senior Legal Advisor ((571) 272-7726), or Hiram

H. Bernstein, Senior Legal Advisor ((571) 272-7707), Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy.

SUPPLEMENTARY INFORMATION: The Leahy-Smith America Invents Act was enacted into law on September 16, 2011. See Pub. L. 112-29, 125 Stat. 284 (2011). This notice proposes changes to the rules of practice to implement Section 8 of the Leahy-Smith America Invents Act, which provides a mechanism for third parties to submit to the Office, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application.

Section 8 of the Leahy-Smith America Invents Act amends 35 U.S.C. 122 by adding 35 U.S.C. 122(e), which enumerates certain conditions that apply to a third-party preissuance submission to the Office in a patent application. Pursuant to 35 U.S.C. 122(e), third-party preissuance submissions of patents, published patent applications, or other printed publications must be made in patent applications before the earlier of:

(a) the date a notice of allowance under 35 U.S.C. 151 is given or mailed in the application; or (b) the later of (i) six months after the date on which the application is first published under 35 U.S.C. 122 by the Office, or (ii) the date of the first rejection under 35 U.S.C. 132 of any claim by the examiner during the examination of the application.

35 U.S.C. 122(e) also requires a concise description of the asserted relevance of each document submitted, a fee as prescribed by the Director, and a statement by the person

making the third-party preissuance submission that the submission was made in compliance with 35 U.S.C. 122(e). A preissuance submission by a third party may be made in any non-provisional utility, design, or plant application, as well as in any continuing or reissue application.

The preissuance submissions by third parties provision of the Leahy-Smith America Invents Act takes effect on September 16, 2012. This provision applies to any patent application filed before, on, or after September 16, 2012.

The Office plans to permit third-party preissuance submissions to be filed via the Office electronic filing system (EFS-Web). However, third-party preissuance submissions, whether submitted in paper or electronically via EFS-Web, would not be automatically entered into the electronic image file wrapper (IFW) for an application. Instead, preissuance submissions submitted by third parties would be reviewed to determine compliance with 35 U.S.C. 122(e) and new 37 CFR 1.290 before being entered into the IFW. Third parties filing preissuance submissions electronically via EFS-Web, will receive immediate, electronic acknowledgment of the Office's receipt of the submission, instead of waiting for the Office to mail a return postcard.

The current EFS-Web Legal Framework prohibits third-party submissions under 37 CFR 1.99 and 37 CFR 1.291 in patent applications because electronically filed documents are instantly loaded into the IFW. See [Legal Framework for Electronic Filing System - Web](#)

(EFS-Web), 74 FR 55200, 55202, 55206-7 (October 27, 2009). Because third-party preissuance submissions would be permitted to be filed electronically under the proposed rule, the Office intends to protect applicants by establishing procedures to determine whether a third-party preissuance submission is in compliance with the requirements of new 37 CFR 1.290 before entering the submission into the IFW of an application or making the submission available to an examiner for consideration. The Office intends to complete such determination, for both paper and electronic submissions, promptly following receipt of the submission so that compliant preissuance submissions would be quickly entered into the IFW and made available to the examiner for consideration. Non-compliant third-party preissuance submissions would not be entered into the IFW of an application or considered and would be discarded. Also, no refund of the required fees would be provided in the event a preissuance submission is determined to be non-compliant. If an electronic mail message address is provided with a third party preissuance submission, the Office may attempt to notify the third party submitter of such non-compliance; however, the statutory time period for making a preissuance submission would not be tolled by the initial non-compliant submission.

The Office does not plan to require that the third party serve the applicant with a copy of the third-party's preissuance submission. Nor does the Office intend to directly notify the applicant upon entry of a third-party preissuance submission. However, the contents of a compliant third-party preissuance submission will be made available to the applicant via its entry in the IFW of the patent application. By not requiring service of third-party

preissuance submissions on the applicant, the Office is underscoring that such third-party submissions will not create a duty on the part of the applicant to independently file the submitted documents with the Office in an information disclosure statement (IDS). Additionally, challenges regarding whether service of a third-party preissuance submission was proper could negatively impact the pendency of the application.

35 U.S.C. 122(e) does not limit third-party preissuance submissions to pending applications. A third-party preissuance submission made within the statutory time period, and otherwise compliant, would be entered even if the application to which the submission is directed has been abandoned. An examiner would not consider such preissuance submission unless the application resumes a pending status (e.g., the application is revived, the notice of abandonment is withdrawn, etc.). The abandonment of an application will not, however, toll the statutory time period for making a preissuance submission. Additionally, a third-party preissuance submission made within the statutory time period, and otherwise compliant, would be entered even if the application to which the submission is directed has not been published.

Compliant third-party preissuance submissions would be considered by the examiner when the examiner next takes up the application for action following the entry of the preissuance submission into the IFW. An examiner would consider the documents and concise descriptions submitted in a compliant third-party preissuance submission in the same manner that the examiner considers information and concise explanations of

relevance submitted as part of an IDS. Generally with the next Office action, a copy of the third party's listing of documents, with an indication of which documents were considered by the examiner, would be provided to the applicant. Documents considered by the examiner would be printed on the patent. Accordingly, an applicant would not need to file an IDS to have the same documents that were previously submitted by a third party as part of a compliant preissuance submission considered by the examiner in the application.

The Office plans to have examiners acknowledge in the record of the patent application the examiner's consideration of the documents submitted. This will be done in a manner similar to that of the examiner's consideration of applicant-submitted documents filed as part of an IDS. For example, the examiner would indicate at the bottom of each page of a preissuance submission "All documents considered except where lined through," along with the examiner's electronic initials and the examiner's electronic signature on the final page of the submission. See, e.g., Manual of Patent Examining Procedure (MPEP) § 609.05(b) (8th ed. 2001) (Rev. 8, July 2010). Such indication by the examiner placed at the bottom of each page of a preissuance submission would mean that the examiner has considered the listed documents and their accompanying concise descriptions. Striking through a document would mean that the examiner did not consider either the document or its accompanying concise description (e.g., because the document was listed improperly, a copy of the document was not submitted, or a concise description was not provided for that document).

Since it would be advantageous for examiners to have the best art before them prior to issuing the first Office action on the merits, and because a first action allowance in the application could close the time period for making a preissuance submission under 35 U.S.C. 122(e), third parties should consider providing any preissuance submission at the earliest opportunity. Additionally, because highly relevant documents can be obfuscated by voluminous submissions, third parties should limit any preissuance submission to the most relevant documents and should avoid submitting documents that are cumulative in nature. Third parties need not submit documents that are cumulative of each other or that are cumulative of information already under consideration by the Office. Third parties are reminded that 35 U.S.C. 122(e) requires that the documents submitted be “of potential relevance to the examination of the application” and that the relevance of each document submitted must be provided in an accompanying concise description.

The Director is proposing to set the fees for third-party preissuance submissions to recover costs to the Office for third-party preissuance submissions to the Office. 35 U.S.C. 122(e) expressly provides for “such fee as the Director may prescribe.” The Office is setting fees for third-party preissuance submissions in this rulemaking pursuant to its authority under 35 U.S.C. 41(d)(2), which provides that fees for all processing, services, or materials relating to patents not specified in 35 U.S.C. 41 are to be set at amounts to recover the estimated average cost to the Office of such processing, services,

or materials. See 35 U.S.C. 41(d)(2). The current rules of practice (37 CFR 1.99) provide for a third-party submission of up to ten documents for the fee set forth in 37 CFR 1.17(p) (currently \$180.00). The Office expects the processing costs to the Office for third-party preissuance submissions under new 37 CFR 1.290 to be equivalent to the processing costs to the Office for submissions under 37 CFR 1.99. Accordingly, the Office has determined that the fee set forth in 37 CFR 1.17(p) would also be applicable to third-party preissuance submissions under 37 CFR 1.290 and proposes to require the fee set forth in 37 CFR 1.17(p) for every ten documents, or fraction thereof, listed in each third-party preissuance submission.

The Office proposes to provide an exemption from this fee requirement where a preissuance submission lists three or fewer total documents and is the first preissuance submission submitted in an application by a third party or a party in privity with the third party. The Office is providing this fee exemption for the first preissuance submission in an application by a third party containing three or fewer total documents because the submission of a limited number of documents is more likely to assist in the examination process and thus offset the cost of processing the submission. Moreover, keeping the size of the fee exempted submission to three or fewer total documents will help to focus the attention of third parties on finding and submitting only the most relevant art to the claims at hand. Where one third party takes advantage of the fee exemption in an application, another third party is not precluded from also taking advantage of the fee

exemption in the same application provided that the third parties are not in privity with each other.

The Office proposes to implement 35 U.S.C. 122(e) in a new rule 37 CFR 1.290 and to eliminate § 1.99. While current § 1.99 provides for third-party submissions of patents, published patent applications, or printed publications, it does not permit an accompanying concise description of relevance of each document and limits the time period for such submissions to up to two months after the date of the patent application publication, or the mailing of a notice of allowance, whichever is earlier. By contrast, new 35 U.S.C. 122(e) and proposed 37 CFR 1.290 permit third parties to submit the same types of documents, but with an accompanying concise description of relevance of each document submitted and provide third parties with the same or more time to file preissuance submissions with the Office when compared with current 37 CFR 1.99. Accordingly, the Office proposes to eliminate 37 CFR 1.99 in favor of new 37 CFR 1.290.

The Office also plans to eliminate the public use proceeding provisions of 37 CFR 1.292. Because Section 6 of the Leahy-Smith America Invents Act makes available a post-grant review proceeding in which prior public use may be raised, the pre-grant public use proceeding set forth in 37 CFR 1.292 is no longer considered necessary. Additionally, information on prior public use may be submitted by third parties by way of a protest in a pending application when the requirements of 37 CFR 1.291 have been met, and

utilization of 37 CFR 1.291 would promote Office efficiency with respect to treatment of these issues. Requests for a public use proceeding under 37 CFR 1.292 are also very rare. The few public use proceedings conducted each year are a source of considerable delay in the involved applications and seldom lead to the rejection of claims.

In view of the proposed elimination of 37 CFR 1.99 and 37 CFR 1.292, the Office proposes to amend 37 CFR 1.17 to eliminate the document submission fees pertaining to 37 CFR 1.99 and 37 CFR 1.292. The Office also proposes to amend 37 CFR 1.17 to add the document submission fees pertaining to new 37 CFR 1.290.

For ease of compliance, the Office proposes to amend 37 CFR 1.291 to make the requirements for submitting protests against pending patent applications more clear and, where appropriate, more consistent with the proposed requirements of new 37 CFR 1.290.

Discussion of Specific Rules:

Title 37 of the Code of Federal Regulations, Part 1, is proposed to be amended as follows:

Section 1.99: Section 1.99 is proposed to be removed and reserved. Section 1.99 is unnecessary because proposed § 1.290 provides for third-party preissuance submissions

of patents, published patent applications, and other printed publications to the Office for consideration and inclusion in the record of a patent application, with a concise description of the relevance of each document being submitted and within time periods that are the same or greater than those permitted under § 1.99.

Section 1.290: Section 1.290(a) as proposed provides that a third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission complies with 35 U.S.C. 122(e) and the requirements of § 1.290, and provides that the submission will not be entered or considered by the Office if the submission is not in compliance with 35 U.S.C. 122(e) and § 1.290. Because § 1.290(a) as proposed requires preissuance submissions be directed to patent applications, the Office would not accept preissuance submissions directed to issued patents. Such submissions should be filed in accordance with § 1.501. Section 1.290(a) as proposed does not require that the application be published. For example, the Office would accept a compliant preissuance submission directed to an application in which a nonpublication request has been filed pursuant to 35 U.S.C. 122(b)(2)(B)(i) and § 1.213. Preissuance submissions under § 1.290 as proposed may be directed to non-provisional utility, design, and plant applications, as well as to continuing and reissue applications.

Also, § 1.290(a) as proposed limits the type of information that may be submitted to patent publications, which include patents and published patent applications, and other

printed publications of potential relevance to the examination of a patent application. For example, a submission under § 1.290 could not include unpublished internal documents or other non-patent documents which do not qualify as “printed publications.” See MPEP § 2128. In the case of a preissuance submission that includes a lengthy document, a third party could submit the relevant portion of the document (e.g., one chapter of a book) in lieu of the entire document where it is practical to do so. Because 35 U.S.C. 122(e) does not limit the type of information that may be submitted to prior art, there is no requirement in § 1.290(a) as proposed that the information submitted be prior art documents in order to be considered by the examiner. Further, in those situations where a third party is asserting that a document submitted is prior art, the third party bears the burden of establishing the date of the document where the date is not apparent from the document regardless whether the document is in paper or electronic format. In such situations, the third party may submit evidence in the form of affidavits, declarations, or other evidence. Such evidence will not be counted toward the document count, unless the document is in the form of a patent document or other printed publication and the document, itself, is listed and submitted for consideration by the examiner.

Section 1.290(b) as proposed sets forth the time periods in which a third party may file a preissuance submission. Under § 1.290(b) as proposed, any third-party submission under this section must be filed before the earlier of: (1) the date a notice of allowance under § 1.311 is given or mailed in the application; or (2) the later of: (i) six months after the date on which the application is first published by the Office under 35 U.S.C. 122(b) and

§ 1.211, or (ii) the date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application.

The time periods provided for in § 1.290(b) are statutory and cannot be waived. Thus, the Office cannot grant any request for extension of the § 1.290(b) time periods. Also, preissuance submissions must be filed before, not on, the dates identified in § 1.290(b)(i), (b)(2)(i), and (b)(2)(ii). A preissuance submission under § 1.290 is filed on its date of receipt in the Office as set forth in § 1.6 (the provisions of § 1.8 do not apply to a preissuance submission under § 1.290). Third-party preissuance submissions that are not timely filed would not be entered or considered and would be discarded.

Proposed § 1.290(b)(2)(i) highlights a distinction in the statutory language of 35 U.S.C. 122 (c) and (e) with respect to publication of the application. 35 U.S.C. 122(c) broadly refers to “publication of the application,” whereas new 35 U.S.C. 122(e) refers to an application “first published under section 122 by the Office.” The § 1.290(b)(2)(i) time period would be initiated only by publications by the Office under 35 U.S.C. 122(b) and § 1.211, and would not be initiated by a publication by the World Intellectual Property Organization (WIPO). Thus, an earlier publication by WIPO of an international application designating the U.S. filed on or after November 29, 2000, would not be considered a publication that would initiate the § 1.290(b)(2)(i) time period for an application which entered the national stage from the international application after compliance with 35 U.S.C. 371. Further, where the Office republishes an application due

to material mistake of the Office pursuant to 37 CFR 1.221(b), the date on which the application is republished will be considered the date the application is “first published by the Office” under § 1.290(b)(2)(i).

The proposed new § 1.290(b)(2)(ii) time period would be initiated by the date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application. The § 1.290(b)(2)(ii) time period would not be initiated, for example, by a first Office action that only contains a restriction requirement or where the first Office action is an action under Ex parte Quayle, 1935 Dec. Comm’r Pat. 11 (1935).

Section 1.290(c) as proposed requires a preissuance submission to be made in writing. For a paper filing, the third party may include a self-addressed postcard with the preissuance submission to receive an acknowledgment by the Office that the preissuance submission has been received. For an electronic filing, the third party will receive immediate, electronic acknowledgment of the Office’s receipt of the submission. In either case, the third party will not receive any communications from the Office relating to the submission other than the self-addressed postcard or electronic acknowledgment of receipt. Section 1.290(c) as proposed also requires that the application to which the third-party submission is directed be identified on each page of the submission by application number (i.e., the series code and serial number), except for the copies of the documents that are being submitted pursuant to § 1.290(d)(3). By requiring identification by

application number, third-party preissuance submissions could be timely matched with the application file and routed to the examiner.

Section 1.290(d)(1) as proposed provides that any third-party submission under § 1.290 must include a list of the documents being submitted, and the listing must include a heading that identifies the listing as a third-party preissuance submission under § 1.290. Proposed § 1.290(e) also sets forth the requirements for identifying the documents being submitted and listed pursuant to § 1.290(d)(1). The Office proposes to provide a form similar to forms PTO/SB/08A and 08B to assist third parties in preparing the listing of documents in accordance with §§ 1.290(d)(1) and (e) and to ensure that the documents are properly made of record in the application file.

Section 1.290(d)(2) as proposed requires a concise description of the asserted relevance of each listed document. 35 U.S.C. 122(e) requires that each third-party preissuance submission be accompanied by a “concise description of the asserted relevance of each document submitted.” The concise description should explain why the respective document has been submitted and how it is of potential relevance to the examination of the application in which the preissuance submission has been filed. Unless there is no concise description provided for a document that is listed, or the concise description is merely a bare statement that the document is relevant and thus does not amount to a meaningful concise description, the Office does not propose to otherwise evaluate the sufficiency of the concise description. It would be a best practice that each concise

description point out the relevant pages or lines of the respective document, particularly where the document is lengthy and complex and the third party can identify a highly relevant section, such as a particular figure or paragraph. The third party may present the concise description in a format that would best explain to the examiner the relevance of the accompanying document, such as in a narrative description or a claim chart. Third parties should refrain from submitting a verbose description of relevance not only because the statute calls for a “concise” description but also because a focused description is more effective in drawing the examiner’s attention to the relevant issues.

Section 1.290(d)(3) as proposed requires submission of a legible copy of each listed document. See § 1.98(a)(2) and MPEP § 609.04(a). Where only the relevant portion of a document is listed, the third party could submit only a copy of that portion (e.g., where a particular chapter of a book is listed and not the entire book). When a copy of only a relevant portion of a document is submitted, the third party should also submit copies of pages of the document that provide identifying information (e.g., a copy of the cover, the title page, the copyright information page, etc.). Under § 1.290(d)(3) as proposed, a third party need not submit copies of U.S. patents and U.S. patent application publications, unless required by the Office, as such documents are readily accessible to examiners.

Section 1.290(d)(4) as proposed requires an English language translation of all relevant portions of any listed non-English language document to be considered by the examiner.

Section 1.290(d)(5)(i) as proposed requires a statement by the party making the submission that the party is not an individual who has a duty to disclose information with respect to the application (i.e., each individual associated with the filing and prosecution of the patent application) under § 1.56. Such statement is intended to avoid potential misuse of preissuance submissions by applicants (e.g., by employing a third party “straw man”) to attempt to circumvent the IDS rules.

Section 1.290(d)(5)(ii) as proposed requires a statement by the party making the submission that the submission complies with the requirements of 35 U.S.C. 122(e) and § 1.290. To facilitate compliance by third parties, the Office proposes to provide a form for third-party preissuance submissions under § 1.290 that includes the statements required by §§ 1.290(d)(5)(i) and (ii).

Section 1.290(e) as proposed sets forth the requirements for identifying the documents submitted and listed pursuant to § 1.290(d)(1). Section 1.290(e) requires that U.S. patents and U.S. patent application publications be listed in a separate section from other documents. Separating the listing of U.S. patents and U.S. patent application publications from the listing of other documents would facilitate printing the U.S. patents and U.S. patent application publications considered by the examiner in a third-party preissuance submission on the face of the patent.

Section 1.290(e)(1) as proposed requires that each U.S. patent be identified by patent number, first named inventor, and issue date. Section 1.290(e)(2) as proposed requires that each U.S. patent application publication be identified by patent application publication number, first named inventor, and publication date. Section 1.290(e)(3) as proposed requires that each foreign patent or published foreign patent application be identified by the country or patent office that issued the patent or published the application, an appropriate document number, first named inventor, and the publication date indicated on the patent or published application. Requiring U.S. and foreign patent and published patent application documents to be identified by the first named inventor should aid in identifying the listed documents in the event the application number, publication number, or other appropriate document number data is inadvertently transposed or otherwise misidentified. Section 1.290(e)(4) as proposed requires that each non-patent publication be identified by publisher, author, title, pages being submitted, publication date, and place of publication, where such information is available. The qualifier “where available” applies to each item of information specified in § 1.290(e)(4). Thus, if an item of information is not available for a particular non-patent publication (e.g., publisher information), the third party need not provide that information, and the citation of the non-patent publication would not be improper as a result of not providing that information. Further, § 1.290(e)(4) as proposed does not preclude additional information not specified in § 1.290(e)(4) from being provided (e.g., journal title and volume/issue information for a journal article).Section 1.290(e)(4) as proposed also provides that the third party bears the burden of establishing the date of a non-patent

publication where the non-patent publication is asserted by the third party to be prior art and the date is not apparent from the document, regardless whether the document is in paper or electronic form.

Section 1.290(f) as proposed requires payment of the fee set forth in § 1.17(p) for every ten documents or fraction thereof being submitted, except where the submission is accompanied by the statement set forth in proposed § 1.290(g). The Office proposes to determine the document count based on the § 1.290(d)(1) listing of documents. Thus, if a document is listed but a copy of the document is not submitted, the listed document would be counted toward the document count. If a copy of a document is submitted but the document is not listed, the document would not be counted or considered and would be discarded. A third party would be permitted to cite less than an entire publication in the § 1.290(d)(1) listing, which would be counted as one document. Further, while a third party would be permitted to cite different publications that are all available from the same electronic source, such as a Web site, each such publication would be counted as a separate document.

Section 1.290(g) as proposed provides an exemption from the § 1.290(f) fee requirement where a preissuance submission listing three or fewer total documents is the first preissuance submission submitted in an application by a third party, or a party in privity with the third party. Where one third party takes advantage of the fee exemption in an application, another third party is not precluded from also taking advantage of the fee

exemption in the same application as long as the third parties are not in privity with each other. For example, applying the current 37 CFR 1.17(p) fee of \$180.00 in accordance with proposed §§ 1.290(f) and (g): (1) no fee would be required for the first preissuance submission by a third party containing three or fewer total documents; (2) a \$180.00 fee would be required for the first preissuance submission by a third party containing more than three, but ten or fewer total documents; and (3) a \$360.00 fee would be required for the first preissuance submission by a third party containing more than ten, but twenty or fewer total documents. For a second or subsequent preissuance submission by the same third party: (1) a \$180.00 fee would be required where the second or subsequent preissuance submission by the third party contains ten or fewer total documents; and (2) a \$360.00 fee would be required where the second or subsequent preissuance submission by the same third party contains more than ten, but twenty or fewer total documents.

To implement the fee exemption in § 1.290(g) and avoid potential misuse of such exemption, the Office proposes to require that exemption-eligible preissuance submissions be accompanied by a statement of the third party that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only preissuance submission submitted in the application by the third party or a party in privity with the third party. To preclude a third party from making multiple preissuance submissions in the same application on the same day and asserting that each such submission is the first preissuance submission being submitted in the application by the third party, the § 1.290(g) statement would require that the submission be the “first

and only” preissuance submission. This statement would not, however, preclude the third party from making more than one preissuance submission in an application, where the need for the subsequent submissions was not known at the time the earlier submission including the § 1.290(g) statement was filed with the Office. Such additional submissions would not be exempt from the § 1.290(f) fee requirement.

The Office does not propose to entertain challenges to the accuracy of such third-party statements because, pursuant to § 11.18(b), whoever knowingly and willfully makes any false, fictitious, or fraudulent statements or representations to the Office shall be subject to the penalties set forth under 18 U.S.C. 1001. Section 11.18(b) applies to any paper presented to the Office, whether by a practitioner or non-practitioner.

Additionally, the Office does not propose to require an explicit identification of a real party in interest because such identification might discourage some third parties from making a preissuance submission or invite challenges based on allegations of misidentification.

Section 1.290(h) as proposed provides that in the absence of a request by the Office, an applicant has no duty to, and need not, reply to a submission under § 1.290. Likewise, because the prosecution of a patent application is an ex parte proceeding, no further response from a third party with respect to an examiner’s treatment of the third party’s preissuance submission would be permitted or considered.

Section 1.290(i) as proposed provides that the provisions of § 1.8 do not apply to the time periods set forth in § 1.290.

Section 1.291: The Office proposes to amend portions of § 1.291 for clarity and also for consistency with new 35 U.S.C. 122(e) and proposed § 1.290.

Section 1.291(b) is proposed to be amended to clarify that the application publication date is the date the application was published under 35 U.S.C. 122(b), and § 1.211 and is also proposed to be amended by including “given or” before “mailed” to provide for electronic notification of the notice of allowance (i.e., e-Office action).

Section 1.291(b)(1) is proposed to be amended to more clearly define the time period for submitting protests under § 1.291 that are accompanied by applicant consent.

Specifically, § 1.291(b)(1) is proposed to be amended to provide that, if a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is filed before a notice of allowance under § 1.311 is given or mailed in the application. This amendment would provide a definite standard for both the Office and third parties and would give more certainty as to when a protest under § 1.291 that is accompanied by applicant consent would or would not be accepted by the Office.

Moreover, it is reasonable that the time period for submission ends when a notice of allowance is given or mailed in the application in view of the current publication process.

Under the current publication process, final electronic capture of information to be printed in a patent will begin as soon as an allowed application is received in the Office of Patent Publication, immediately after the notice of allowance has been given or mailed. See MPEP § 1309.

Section 1.291(c)(1) is proposed to be amended to set forth the requirements for identifying the information being submitted and listed, consistent with proposed § 1.290(e). Section 1.291(c)(1)(i) as proposed to be amended requires that each U.S. patent be identified by patent number, first named inventor, and issue date. Section 1.291(c)(1)(ii) as proposed to be amended requires that each U.S. patent application publication be identified by patent application publication number, first named inventor, and publication date. Section 1.291(c)(1)(iii) as proposed to be amended requires that each foreign patent or published foreign patent application be identified by the country or patent office that issued the patent or published the application, an appropriate document number, first named inventor, and the publication date indicated on the patent or published application. Section 1.291(c)(1)(iv) as proposed to be amended requires that each non-patent publication be identified by publisher, author, title, pages being submitted, publication date, and place of publication, where such information is available. The qualifier “where such information is available” applies to each item of information specified in § 1.291(c)(1)(iv). Thus, if an item of information is not available for a particular non-patent publication (e.g., publisher information), the protestor need not provide that information, and the citation of the non-patent publication

would not be improper as a result of not providing that information. Further, § 1.291(c)(1)(iv) as proposed to be amended does not preclude additional information not specified in § 1.291(c)(1)(iv) from being provided (e.g., journal title and volume/issue information for a journal article). Section 1.291(c)(1)(v) as proposed to be amended requires that each item of other information be identified by date, if known. Requiring U.S. and foreign patent and published patent application documents to be identified by the first named inventor should aid in identifying the listed documents in the event the application number, publication number, or other appropriate document number data is inadvertently transposed or otherwise misidentified.

Section 1.291(c)(2) is proposed to be amended to change “explanation” to “description” to conform to proposed § 1.290(d)(2). This amendment would clarify that there is no difference between the concise description of relevance for a third-party preissuance submission and the concise description of relevance for a protest.

Section 1.291(c)(3) is proposed to be amended to clarify that copies of information submitted must be legible. See § 1.98(a)(2) and MPEP § 609.04(a). Section 1.291(c)(3) is also proposed to be amended to provide that copies of U.S. patents and U.S. patent application publications would not need to be submitted, unless required by the Office, as such documents are readily accessible to examiners.

Section 1.292: Section 1.292 is proposed to be removed and reserved. The practice of providing a pre-grant public use proceeding as set forth in § 1.292 is no longer considered necessary, and is inefficient as compared to alternative mechanisms available to third parties for raising prior public use; for example, as provided for by § 1.291 protests, where appropriate, and also by Section 6 of the Leahy-Smith America Invents Act which makes available a post-grant review proceeding.

Sections 1.17 and 41.202: Sections 1.17 and 41.202 would also be amended to change or remove references to §§ 1.99 and 1.292, for consistency with the proposed addition of new § 1.290 and removal of §§ 1.99 and 1.292. Section 1.17(i) would also be amended to correct a misidentification of § 1.53(b)(3) to § 1.53(c)(3) concerning the fee for converting a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

Rulemaking Considerations:

A. Administrative Procedure Act: This notice proposes changes to the rules of practice concerning the procedure for filing third party preissuance submissions. The changes proposed in this notice do not change the substantive criteria of patentability. Therefore, the changes in this proposed rule are merely procedural and/or interpretive. See Bachow Communs., Inc. v. FCC, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure

Act); Inova Alexandria Hosp. v. Shalala, 244 F.3d 242, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims); Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law) and thirty-day advance publication is not required pursuant to 5 U.S.C. 553(d) (or any other law). See Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.”) (quoting 5 U.S.C. 553(b)(A)). The Office, however, is publishing these changes and the Regulatory Flexibility Act certification discussion below, for comment as it seeks the benefit of the public’s views on the Office’s proposed implementation of this provision of the Leahy-Smith America Invents Act.

B. Regulatory Flexibility Act: For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b). This notice proposes changes to the rules

of practice to implement section 8 of the Leahy-Smith America Invents Act, which provides a mechanism for third parties to submit to the Office, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application.

The changes proposed in this notice concern requirements for third parties submitting patents, published patent applications, or other printed publications in a patent application. The burden to all entities, including small entities, imposed by these rules is a minor addition to that of the current regulations for third-party submissions under § 1.99. Consistent with the current regulations, the Office will continue to require third parties filing submissions to, for example, file a listing of the documents submitted along with a copy of each document, with minor additional formatting requirements.

Additional requirements proposed in this notice are requirements of statute (e.g., the concise explanation) and thus the sole means of accomplishing the purpose of the statute. Because of the expanded scope of submissions under this rulemaking and additional requirements by statute, the Office believes this will take a total of 10 hours at a cost of \$3,400.00 per submission. Furthermore, the Office estimates that no more than 730 small entity third parties will make preissuance submissions per year. Therefore, the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

F. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

G. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

I. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

L. Unfunded Mandates Reform Act of 1995: The changes proposed in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no

actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

M. National Environmental Policy Act: This rulemaking will not have any effect on the quality of environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

N. National Technology Transfer and Advancement Act: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions which involve the use of technical standards.

O. Paperwork Reduction Act: The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This rulemaking proposes changes to the rules of practice that would impact existing information collection requirements previously approved by the Office of Management and Budget (OMB) under OMB Control Number 0651-0062. Accordingly, the Office will submit to the OMB a proposed revision to the information collection requirements under 0651-0062. The proposed revision will be available at the OMB's Information Collection Review Web site (www.reginfo.gov/public/do/PRAMain).

Needs and Uses: This information collection is necessary so that the public may submit patents, published patent applications, and other printed publications to the Office for consideration in a patent application. The Office will use this information, as appropriate, during the patent examination process to assist in evaluating the patent application. The Office will provide a form (PTO/SB/429) to assist the public in making a submission of patents, published patent applications, and other printed publications for consideration in a patent application.

Title of Collection: Third-Party Submissions and Protests.

OMB Control Number: 0651-0062.

Form Numbers: PTO/SB/429.

Method of Collection: By mail, facsimile, hand delivery, or electronically to the Office.

Affected Public: Individuals or households; businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: 1,030 responses filed per year.

Estimated Time Per Response: The Office estimates that the responses in this collection will take the public 10 hours.

Estimated Total Annual Respondent Burden Hours: 10,300 hours per year.

Estimated Total Annual Respondent Cost Burden: \$3,502,000 per year.

Estimated Total Annual Non-hour Respondent Cost Burden: \$185,400 per year in the form of filing fees.

The Office is soliciting comments to: (1) evaluate whether the proposed information requirement is necessary for the proper performance of the functions of the Office, including whether the information will have practical utility; (2) evaluate the accuracy of the Office's estimate of the burden; (3) enhance the quality, utility, and clarity of the information to be collected; and (4) minimize the burden of collecting the information on those who are to respond, including by using appropriate automated, electronic, mechanical or other technological collection techniques or other forms of information technology.

Please send comments on or before [Insert date 60 days after publication in the FEDERAL REGISTER] to Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of Raul Tamayo,

Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy. Comments should also be submitted to the Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street, N.W., Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act, unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is proposed to be amended as follows:

PART 1 — RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.99 is removed and reserved.

§ 1.99 [Reserved]

3. Section 1.290 is added as follows:

§ 1.290 Submissions by third parties in applications.

(a) A third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission is in compliance with 35 U.S.C. 122(e) and this section. A third-party submission in an application will not be entered or considered by the Office if the submission is not in compliance with 35 U.S.C. 122(e) and this section.

(b) Any third-party submission under this section must be filed before the earlier of:

(1) The date a notice of allowance under § 1.311 is given or mailed in the application; or

(2) The later of:

(i) Six months after the date on which the application is first published by the Office under 35 U.S.C. 122(b) and § 1.211, or

(ii) The date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application.

(c) Any third-party submission under this section must be made in writing, and identify on each page of the submission, except for copies required by paragraph (d)(3) of this section, the application to which the submission is directed by application number.

(d) Any third-party submission under this section must include:

(1) A list of the documents being submitted;

(2) A concise description of the asserted relevance of each listed document;

(3) A legible copy of each listed document, or the portion which caused it to be listed, other than U.S. patents and U.S. patent application publications, unless required by the Office;

(4) An English language translation of all relevant portions of any listed non-English language document to be considered by the examiner; and

(5) A statement by the party making the submission that:

(i) The party is not an individual who has a duty to disclose information with respect to the application under § 1.56; and

(ii) The submission complies with the requirements of 35 U.S.C. 122(e) and this section.

(e) The list of documents required by paragraph (d)(1) of this section must list U.S. patents and U.S. patent application publications in a separate section from other documents, include a heading that identifies the listing as a third-party preissuance submission under § 1.290, and identify each:

(1) U.S. patent by patent number, first named inventor, and issue date;

(2) U.S. patent application publication by patent application publication number, first named inventor, and publication date;

(3) Foreign patent or published foreign patent application by the country or patent office that issued the patent or published the application, first named inventor, an appropriate document number, and the publication date indicated on the patent or published application; and

(4) Non-patent publication by publisher, author, title, pages being submitted, publication date, and place of publication, where available. If not apparent from the document, the third party bears the burden of establishing the date of a non-patent publication where asserted to be prior art.

(f) Any third-party submission under this section must be accompanied by the fee set forth in § 1.17(p) for every ten documents or fraction thereof being submitted.

(g) The fee otherwise required by paragraph (f) of this section is not required for a submission listing three or fewer total documents that is accompanied by a statement by the party making the submission that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only submission under 35 U.S.C. 122(e) submitted in the application by the party or a party in privity with the party.

(h) In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a submission under this section.

(i) The provisions of § 1.8 do not apply to the time periods set forth in this section.

4. Section 1.291 is amended by revising the introductory text of paragraph (b) and paragraphs (b)(1) and (c) to read as follows:

§ 1.291 Protests by the public against pending applications.

* * * * *

(b) The protest will be entered into the record of the application if, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under 35 U.S.C. 122(b) and § 1.211, or a notice of allowance under § 1.311 was given or mailed, whichever occurs first.

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is filed before a notice of allowance under § 1.311 is given or mailed in the application.

* * * * *

(c) In addition to compliance with paragraphs (a) and (b) of this section, a protest must include:

(1) A listing of the patents, publications, or other information relied upon identifying:

(i) Each U.S. patent by patent number, first named inventor, and issue date;

(ii) Each U.S. patent application publication by patent application publication number, first named inventor, and publication date;

(iii) Each foreign patent or published foreign patent application by the country or patent office that issued the patent or published the application, an appropriate document number, first named inventor, and the publication date indicated on the patent or published application;

(iv) Each printed publication is identified by publisher, author, title, pages being submitted, publication date, and place of publication, where available; and

(vi) Each item of other information by date, if known.

(2) A concise description of the relevance of each item listed pursuant to paragraph (c)(1) of this section;

(3) A legible copy of each listed patent, publication, or other item of information in written form, or at least the pertinent portions thereof, other than U.S. patents and U.S. patent application publications, unless required by the Office;

* * * * *

5. Section 1.292 is removed and reserved.

§ 1.292 [Reserved]

Date: December 30, 2011_____

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

[FR Doc. 2011-33811 Filed 01/04/2012 at 8:45 am; Publication Date: 01/05/2012]